REMARKS

This responds to the Office Action mailed on June 5, 2009.

Claims 1-20, 25, 27-33, and 40-50 are amended, no claims are canceled, and no claims are added; as a result, claims 1-50 are pending in this application.

§ 101 Rejection of the Claims

Claims 1-13 and 27-50 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action asserts that claims 1-13 are non-statutory because the claims allegedly are not tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. As recently determined by the Court of Appeals for the Federal Circuit (CAFC), claims to computer implemented methods do not need to explicitly recite a physical transformation nor a concrete or tangible result[1]. Rather, the subject matter patentability of claims to computer implemented methods is determined by the Bilski machine-or-transformation test. "The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies §101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. Bilski citing Benson, 409 U.S. at 70. It is enough for subject matter patentability that the claimed invention is tied to a particular machine, or the claim transforms an article. Such a tying to a particular machine is clearly present in the claims as currently presented. In particular, in the method as claimed in claim 1, the computer-implemented method includes using a data processor to parameterize a routing policy. Thus, the method claimed in claim 1, and its dependent claims (2-13), is clearly tied to a particular machine (e.g., a data processor to parameterize a routing policy). As such, claims 1-13 as presently presented are statutory under 35 U.S.C. §101.

The Office Action also asserts that claims 27-39 are non-statutory because the claims are allegedly directed to functional descriptive material. However, claim 27 has been amended herein to include a data processor and an information storage mechanism. Both of these elements

[1] In Re Bernard L. Bilski et al., 545 F.3rd 943, 88 USPQ2d 1385 (Fed.Cir. 2008); State St. Bank and Trust Co. v. Signature Fin. Group, Inc., 149 F.3d 1368 (Fed. CIR. 1999); Ex Parte Lundgren, F.3d, 2004, WL 3561262 (Fed. Cir. 2004); Diamond v. Diehr, 450 U.S. 175 (1981), Diamond v. Chakrabarty, 447 U.S. 303 (1980).

of the pending claims are statutory elements. Thus, the system claimed in claim 27, and its dependent claims (28-39), clearly recites a statutory combination of elements. As such, claims 27-39 as presently presented are statutory under 35 U.S.C. §101.

The Office Action also asserts that claims 40-50 are non-statutory because the claims are allegedly directed to machine-readable media including radio wave communications. Claim 40 has been amended herein to recite, "A machine-readable storage medium." Additionally, the specification has been amended herein to clarify the claimed machine-readable storage medium. No new matter has been added thereby. As such, the machine-readable storage medium claimed in claim 40, and its dependent claims (41-50), clearly recites a statutory combination of elements. As such, claims 40-50 as presently presented are statutory under 35 U.S.C. §101.

The Applicants therefore respectfully request withdrawal of the §101 rejections.

§ 112 Rejection of the Claims

Claims 5-11, 18-24, 31-37, and 45-49 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The claims have been amended herein to clarify the noted indefiniteness. Thus, the Applicants therefore respectfully request withdrawal of the §112 rejections.

§ 102 Rejection of the Claims

Claims 1-50 were rejected under 35 U.S.C. § 102(e) as being anticipated by Odiaka (U.S. Patent No. 6,829,347).

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."[2] It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed

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[2] *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)

invention, arranged as in the claim."[3]   Furthermore, "[T]he exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference."[4]

Odiaka describes a method of selecting a trail using a constraint based routing technique in which at least one user-determined routing policy is used to bias input to a Dijkstra/Yen-K shortest path routing engine, so as to limit output by the routine engine to routes conforming with the user-determined routing policy.

On pages 6-7 of the Office Action, the following is asserted:

> 20. As to claims 5, 18, 31, and 45, Odiaka discloses identifying one or more common blocks of policy statements within the policy (column 6, lines 60-63 and column 7, Table 1; default values read on common blocks); assigning sets of parameters to elements of the one or more common blocks (column 7, Table 1; "Default Values"); and storing the parameter sets in a parameter table, the table associating each set of parameters with either the customer or the customer class (column 7, Table 1; further column 7, lines 17-26, defines various default policies based upon customer needs). (emphasis added).

However, the Office Action fails to explain how default values, such as the default values shown in Odiaka, are suggestive of the identification of common blocks of policy statements as claimed (e.g., see amended claims 1, 14, 27, and 40). As clearly described in the present application, the claimed policy statements are not merely parameter values, default or otherwise, as asserted in the Office Action. In contrast, the policy statements as currently claimed are described in the present specification. An example is provided below:

> In some embodiments, parameterization is applied to routing policy and routing-policy configuration. In these embodiments, routing-policy language for a router includes two major constructs to a configuration, which may significantly reduce the amount of configuration required to specify routing policy. The first construct provides a basic modularity such that common blocks of policy may be specified once and reused. In some embodiments, hierarchical reuse may be used where a policy may reuse and/or make reference to one or more common policy blocks. More than one level of hierarchy may also be permitted. The second construct may allow common blocks of policy to be parameterized. Parameterization allows policies that share similar structure and may reference different values within that structure to be defined, stored and maintained once. Each variant or invocation of

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[3] *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983))

[4] *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 USPQ 781, 789 (Fed Cir. 1983)

a parameterized policy may maintain appropriate parameters for a variant rather storing and maintaining a full copy of each variant of the policy. (Present Specification, pg. 2, lines 8-21)

Odiaka does not disclose or suggest a method, apparatus, or system to parameterize a routing policy, wherein the parameterizing includes identifying one or more common blocks of policy statements within the routing policy, assigning sets of parameters to elements of the one or more common blocks, and enabling a hierarchical arrangement of the one or more common blocks of policy statements within the routing policy as currently claimed (e.g., see amended claims 1, 14, 27, and 40). Odiaka does not disclose or suggest identifying common blocks of policy statements. Odiaka does not disclose or suggest a hierarchical arrangement of common blocks of policy statements. As such, Odiaka does not anticipate or suggest the presently claimed embodiments of claims 1-50.

The Applicants respectfully request withdrawal of the §102(e) rejections.

AMENDMENT AND RESPONSE UNDER 37 C.F.R § 1.111
Serial Number: 10/765,756
Filing Date: January 27, 2004
Title: ROUTING SYSTEMS AND METHODS FOR IMPLEMENTING ROUTING POLICY WITH REDUCED CONFIGURATION AND
NEW CONFIGURATION CAPABILITIES
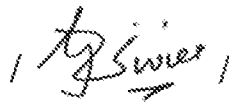
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Dkt: 1370.065US1

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (408) 406-4855 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.
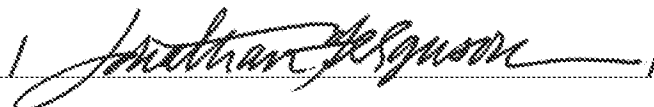
Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402-0938
(408) 278-4041

Date ___October 5, 2009___   By _____

Garth Vivier
Reg. No. 57,313

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 5th day of October, 2009.

Jonathan Ferguson